

REMARKS

The Examiner in the official action objected to claim 8. Applicants have amended claim 8 in two specific instances such that now two claims start by “forwarding said identifying data to said service provider” and “placing an order by said third party for goods and/or services” respectfully. It is believed that these changes comply with the Examiner’s objection and do not change the scope of the claim in any respect, but simply modifies the claim in a form suggested by the Examiner.

With regard to the rejection of claim 8 under 35 USC § 112 second paragraph, Applicant does not understand what step is missing. As the claim clearly sets forth in the fourth paragraph “transmitting said electronic images to said third party along with said identifying data with respect to said images transmitted”. This is the step wherein the data is actually forwarded to the third party. In the previous step, there is the forwarding of the identifying data to the service provider. Therefore, it is not believed that there is any omitted step in this regard as the claim specifically sets forth the forwarding identifying data to the service provider and also provides the step of transmitting the electronic images to a third party along with the identifying data. At this point in time, an order may be placed by the third party. While the order may not be able to be fulfilled until the images are actually sent to the image provider, an order for the goods or services can indeed be provided and placed with the service provider.

The Examiner has maintained the rejection of claims 1, 8 and 9 under 35 USC § 103(a) as being unpatentable over McIntyre in view of Enomoto and further in view of Garfinkle for reasons set forth therein. In this regard, the Examiner has not provided any patentable weight to the limitation of the camera having a switch that results in the creation of identifying data then identifies the images are or have been forwarded to a third party for ordering goods or services. In this regard, Applicant refers the Examiner to MPEP 2173.05 (g) which clearly set forth that functional limitations are indeed appropriate. As set forth therein, there is nothing inherently wrong with defining some part of an invention in a functional term. Functional language does not in and of itself render a claim improper. A functional limitation must be evaluated and considered, just like any other limitation of the claim for what it clearly conveys to a person of ordinary

skill in the art. Thus, Applicant respectfully submits that the Examiner cannot ignore this functional limitation.

The McIntyre reference clearly does not teach or suggest transmitting to a third party data with regard to images that have been captured that can be used for ordering goods or services nor does McIntyre teach or suggest the forwarding of this data to the service provider.

With regard to the Enomoto reference, this reference does not teach or suggest the forwarding of identifying data to a third party such that the third party can order goods with regard to images that are provided to a service provider as taught and claimed by Applicant. Applicant respectfully submit that the Enomoto reference does not teach or suggest anything that would render Applicant's invention obvious. The Enomoto reference is simply directed to an individual ordering directly from a service provider over a communication network.

With regard to the Sheridan, Garfinkle and Fredlund references cited, these all deal with respect to images that have been received by the photofinisher wherein a third party later has the ability to place an order. With the present invention, orders are capable of being placed by third parties prior to the images being received by the service provider. No where is it taught or suggested that third parties can do this. The prior art systems all require the identification and location of the images on the system in order to allow third parties to be able to access and place orders. In the present invention, third parties are able to place orders even with respect to images that have not yet been provided to the service provider. Since the prior art fails to teach or suggest essential elements of the claimed invention, it is respectfully submitted that the prior art could not teach or suggest the invention. As set forth in MPEP 2143.03 all claim limitation must be taught or suggested. Here the prior art totally fails to teach or suggest the limitation as set forth by Applicant. Therefore, Applicant respectfully submit that the claims in their present form are in condition for allowance.

The remaining dependent claims all depend at least ultimately upon independent claim 1 which has been shown to be patentably distinct, thus, these claims are also patentably distinct for the same reasons discussed with regard to the independent claims.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,



Attorney for Applicant(s)
Registration No. 27,370

Frank Pincelli/phw
Rochester, NY 14650
Telephone: 585-588-2728
Facsimile: 585-477-4646